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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/735,621

12/16/2003

Akira Shimizu

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07/07/2006

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EXAMINER

ARANCIBIA, MAUREEN GRAMAGLIA

ART UNIT

PAPER NUMBER

1763

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/735,621

Applicant(s)

SHIMIZU ET AL.

Examiner

Maureen G. Arancibia

Art Unit

1763

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 4-6, 15-17 and 28.
Claim(s) rejected: 1-3, 7-14, 18-22 and 27.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 06/06
13. ☐ Other: _____.

Maureen G. Arancibia

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**PARVIZ HASSANZADEH
SUPERVISORY PATENT EXAMINER**

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments filed 20 June 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the disclosed substrate holder in the instant application permits suppression or reduction of unnecessary discharge occurring in a gap between the substrate holder and an electrode, as well as suppression or reduction of an uneven discharge on a substrate, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In regards to Applicant's argument against the rejection of Claim 1 as being anticipated by Bubenzer et al., the Examiner maintains that element 19 of Bubenzer et al. may be considered a substrate holder, as broadly recited in the claim, since it supports (holds) a substrate layer 23 to be processed. Conductive member 26 is electrically connected to electrode 5 and the substrate holder 19, as required by the claim. (Bubenzer et al., Abstract)

Applicant's arguments that element 19 can not be considered to be a substrate holder, and that element 23 can not be considered to be a substrate, are not convincing. The Examiner agrees that the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In *re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). This is because Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). In the instant case, one of ordinary skill in the art would recognize that a substrate holder, broadly recited, may be a component that holds an element to be processed. In the case of Bubenzer et al., the element 19 holds another element 23 to be processed, and thus may broadly be considered a substrate holder.

Moreover, it is noted that the instant claims are apparatus claims, not process claims. The prior art structure must be capable of performing the intended use recited in the claims. In the instant case, even if element 23 of Bubenzer et al. were not considered to be a substrate, element 19 would still be structurally capable of holding a substrate. Likewise, even if Bubenzer et al. were not considered to expressly teach the deposition of additional thin films on element 23, the apparatus taught by Bubenzer et al. would still be structurally capable of depositing additional thin films, whether on element 23 or another substrate. That Bubenzer et al. may call the various elements by certain terms does not prevent those elements from meeting the structural limitations recited in the claims.

In other words, element 19 of Bubenzer et al. meets the structural limitations of the substrate holder as recited in the claims. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In regards to Applicant's argument against the rejection of Claims 12 and 27, the Examiner recognizes that Bubenzer et al. fails to expressly teach certain features recited in Claims 12 and 27. Therefore, Claims 12 and 27 were rejected under 35 U.S.C. 103 on the grounds that it would have been obvious to one of ordinary skill in the art to construct conductive member 26 of a plurality of juxtaposed, closely spaced conductive strips, in order to allow damaged or overly coated (Bubenzer et al., Abstract) sections to be replaced without necessitating replacement of the entire conductive piece.

The Examiner notes that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner asserts that the motivation to modify the teachings of Bubenzer et al. would have been found in the knowledge generally available to one of ordinary skill in the art, as described above.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The Examiner notes that an official translation of Bubenzer et al. has been ordered, and will be provided with any subsequent office action.